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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/777,588

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Yuri Itkis

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EXAMINER

HOEL, MATTHEW D

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/777,588	Applicant(s) ITKIS ET AL.	
	Examiner Matthew D. Hoel	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

2. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

4. Determining the scope and contents of the prior art.
5. Ascertaining the differences between the prior art and the claims at issue.
6. Resolving the level of ordinary skill in the pertinent art.
7. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 57 to 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franchi (U.S. patent 5,770,533 A) in view of Gimmon (U.S. patent 5,096,195 A).

9. As to Claim 57: '533 discloses all of the elements of Claim 1, but lacks specificity as to the gaming device receiving data via a first two-way communication channel from the computer while being housed in the dispenser with the first communication channel being secure. Franchi teaches in '533 a self-service dispenser for dispensing at least one portable gaming device with the dispenser being controlled by a computer and the computer operationally interfaced with a first transceiver (Col. 15, Lines 38 to 54; Col. 16, Lines 18 to 22). The data enables operation of the gaming device following the

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dispensing of the gaming device from the dispenser, with the portable gaming device including a second transceiver and being in wireless communication with the computer via a second two-way communication channel comprising a first and second transceiver (Col. 15, Lines 26 to 37). '195, however, teaches the gaming device receiving data via a first two-way communication channel from the computer while being housed in the dispenser, with the first communication channel being secure (authorizes gaming unit, Fig. 6; Col. 6, Line 46 to Col. 7, Line 2). It would be obvious to one of ordinary skill in the art to apply the hardwired two-way communication channel of '195 to the dispenser of '533. Both inventions are dispensers that dispense multiple portable gaming units to customers on a rental basis. The authorization scheme of '195 shown in Fig. 6 could be used to protect the customer accounts detailed in '533 (Col. 6, Lines 30 to 36). The advantage of this combination is that the hard-wired communication while the portable game is in the dispenser would be more secure than the wireless communication used while the game is out of the dispenser.

10. As to Claim 58: '533 includes a latch for securing the gaming device in the dispenser, with the latch being released upon a predetermined event (physically releases RSAT, latching mechanism inherent, Col. 15, Lines 38 to 44).

11. As to Claim 59: The predetermined event that releases the latch in '533 is the insertion of monetary consideration into the dispenser (Col. 15, Lines 44 to 47).

12. As to Claim 60: In '533 the dispenser receives from the gaming device an identification of the gaming device when the gaming device is housed in the dispenser (RSAT necessarily identifies itself when returned, Col. 16, Lines 14 to 17).

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13. As to Claim 61: The data in '533 can be a bingo card (Col. 8, Lines 35 to 38).

14. Claims 62 to 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over '533 and '195 in view of Walker, et al. (U.S. patent 6,024,640 A).

15. As to Claim 62: The combination of '533 and '195 discloses all of the elements of Claim 62, but lacks specificity as to the data including an encryption key. '640, however, teaches a portable wireless gaming device that uses encrypted communication (146, 148, and 150, Fig. 6). It would be obvious to one of ordinary skill in the art to apply the wireless encryption of '640 to the combination of '533 and '195. '195 in Fig. 6 checks the identity of the gaming device, which would ideally be done through encryption. '533 can be used for lottery applications (Col. 8, Lines 35 to 38), like '640. The advantage of this combination would be to further secure the gaming system communications.

16. As to Claim 63: In '533 the portable gaming device includes a transceiver for wireless communication with the computer while being outside of the dispenser.

17. As to Claim 64: The dispenser of '195 charges a gaming device battery while the gaming device is housed in the dispenser.

18. Claims 65 to 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over '533, '195, and '640 in view of Rocco, et al. (U.S. pre-grant publication 2001/0035425 A1).

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19. As to Claim 65: The combination of '533, '195, and '640 discloses all of the elements of Claim 65, but lacks specificity as to a bill validator for accepting monetary consideration in return for the gaming device. '425, however, teaches a bill acceptor for the dispensing of electronic handheld communication devices (Para. 4, Claim 1). The invention of '195 dispenses portable wireless electronic devices like '533. '533 teaches a cash slot at a blackjack table (Fig. 7) and dispensers at gaming tables (Col. 15, Lines 55 to 65). The advantage of this combination would be to automate the cash collection process of '533 by having it done by the dispenser.

20. As to Claim 66: The dispenser of '533 includes a card reader for reading a player club card (Col. 15, Lines 38 to 54).

21. As to Claim 67: '195's dispenser includes a printer for printing a sales receipt (121, Fig. 8).

22. As to Claim 68: The dispenser of '533 includes a barcode reader for reading barcodes (Col. 10, Lines 32 to 34).

23. As to Claim 69: The dispenser of '533 maintains an account for at least one user of a gaming device (Col. 6, Lines 30 to 36).

24. As to Claims 70 and 71: '533 is capable of crediting the players account upon return of the gaming device to the dispenser and refunding the balance of the account upon return of the gaming device to the dispenser (Col. 6, Lines 30 to 36; Col. 15, Lines 49 to 54).

25. As to Claim 72: The RSAT of '533 can communicate with the computer by infrared communication (Col. 16, Lines 18 to 22).

26. As to Claims 73 to 79: '533 teaches a self-service dispenser for dispensing at least one portable gaming device (Col. 15, Lines 38 to 54). The dispenser of '195 is controlled by a computer (Fig. 3). The dispenser includes a latch for securing the gaming device in the dispenser, with the latch being controlled by the computer and released upon a predetermined event ('533, dispenser reads player card and releases RSAT upon sufficient player balance, Col. 15, Lines 38 to 54). The gaming device is able to receive data while housed in the dispenser ('195, Col. 6, Line 46 to Col. 7, Line 2). Data enables operation of the portable gaming device following dispensing from the dispenser ('533, Col. 15, Lines 26 to 37, Col. 15, Line 66 to Col. 16, Line 13). '533 releases the portable gaming device upon insertion of monetary consideration (Col. 15, Lines 38 to 54). '195 teaches a bill validator (Para. 4, Claim 1). '533 teaches a barcode reader (Col. 10, Lines 32 to 34). '533 teaches a magnetic card reader (Col. 2, Lines 51 to 54; Col. 15, Lines 38 to 55). In light of the fact that in '533 winnings and losses are credited to the player and the player's card is released upon return of the RSAT (Col. 15, Lines 38 to 55) and '640 teaches bonus awards, it would be an obvious design choice to return a deposit to a player or award bonus points as an incentive for returning the portable gaming device.

Response to Arguments

27. Applicant's arguments filed June 14th, 2006 have been fully considered but they are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be

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established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, '195 teaches a hard-wired two-way communication channel with the computer while the portable gaming unit is stored in the cradle or docking station (20, Fig. 4; Col. 3, Lines 26 to 62). This is a secure communication channel in that is less easily tampered with than the wireless communication of '533. It is widely known that hackers with wireless laptops engage in a practice called "war driving" in which they use port scanners and other software tools to find vulnerabilities in unsecured networks. Hardwired channels in a gaming device would be nearly impossible for cheating players to tamper with, given that all modern casinos have surveillance cameras and personnel trained to watch for suspicious activity. Gaming hardware can further be secured with physical locks and tamper seals, as well as encryption for data being passed across busses. The combination of '195 and '533 would render the system of '533 more secure in that the communication would be hard-wired while the device is in the cradle, as opposed to wireless the entire time.

28. The applicants state on Page 4 of their remarks "...if such data is provided from the RSAT holder or the computer system to the RSAT 1600 while the RSAT 1600 is housed within the RSAT holder, there is no longer a need to provide betting cards to player rendering the Franchi invention unsatisfactory for its intended purpose.

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Moreover, eliminating the betting cards changes the principle of operation and objectives of Franchi, which is to provide betting cards having improved security to casino players.” Eliminating the cards of ‘533 or changing the mode of operation of ‘533 is nowhere suggested in the previous action or by the 103 combination of ‘533 and ‘195. Indeed, the card of ‘533 is only one embodiment of ‘533 and is meant to be used in conjunction with two-way communication with the computer while the RSAT (portable gaming device) is still in the docking station. The spirit of ‘533 is embodied in the steps in Columns 5 and 6: “301-Player inserts betting card into individual player console. 302-Individual console reads information on betting card. 303-Individual player console transmits the information to the individual game computer. 304-Individual game computer transmits the information to the central computer. 305-The information is received and read by the central computer. 306-The central computer compares the information with information stored in the central computer. 307-If the information is not the same, the central computer transmits denial information to the individual computer. 308-The individual game computer receives the denial information and transmits it to the individual player console. 309-The individual player console ejects the betting card and displays a “See Cashier” message. 310-If the information stored in the central computer is the same as that on the betting card, the betting card information is then compared to the criteria required to play the game. 311-If the criteria are not satisfied, a denial signal is transmitted as described in boxes 307, 308, and 309. 312-If the information satisfies the criteria, the central computer transmits acceptance to the individual game computer. 313-The individual game computer transmits acceptance to

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the individual player console. 314-The individual player console displays player information and enables play.” Lines 30 to 36 of Col. 6 explain how the central computer keeps the running total of debits and credits for the player. Col. 15, Lines 38 to 54 only talk about the embodiment of ‘533 that involves the RSAT (portable gaming device); the steps here do not conflict with those in Cols. 5 and 6. In this embodiment, the step corresponding to 314 enables play by physically releasing the RSAT from the controller. Col. 15, Lines 26 to 37 talks about how the RSAT is wireless, so the communication going on from steps 301 to 314 are done wirelessly. The 103 combination with ‘195 improved upon this by having hardwired communication while the portable gaming device is in the cradle or dispenser, providing more secure communication. The second two-way communication channel of Claim 56 is the wireless channel of ‘533; the first and secure two-way communication channel of Claim 56 is the wired channel of ‘195. The examiner notes that “secure” is not defined in Claim 56. The claim was interpreted as broadly as reasonable without reading the limitations of the specification into the claim.

29. ‘533 and ‘195 are clearly analogous art. Both inventions involve dispensers which dispense portable gaming units to be used for a short time (a typical gambling session) and then returned, after which the player is debited or credited according to the player’s skill or luck in playing (‘533, Col. 15, Lines 26 to 54, Figs. 16 and 17; ‘195, Abst., Figs. 1-3). Regarding the applicants’ assertion that the combination of ‘533 and ‘195 does not suggest the provide a gaming device capable of receiving data from a computer while housed in a dispenser, the examiner points the applicants to the steps

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301 to 314 in Cols. 5 and 6 of '533 and the embodiment of the wireless gaming device in the dispenser of Col. 15. '195 also teaches a gaming device receiving information from a computer while in a dispenser (Fig. 4, load and unload game unit data between central computer and game unit). The examiner respectfully disagrees with the applicants as to the claims' condition for allowability.

Citation of Pertinent Prior Art

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kanoh, et al. in U.S. patent 5,812,641 A teach renting portable communication devices. Richardson, et al. in U.S. patent 5,072,381 A teach a docking station for electronic bingo games. Miller, et al. in U.S. patent 6,354,941 B2 teach docking stations for electronic games. Angell, et al. in U.S. patent 6,702,672 B1 teach players renting and returning wireless gambling devices. Ichikawa in U.S. patent 6,644,455 B2 teaches a rental system for digital cameras. The search report for WIPO publication WO 91/18468 A1, application PCT/US91/03583, is considered to be relevant. The abstract for EPO publication EP 1 274 048 A2, application 02014785.6, is considered to be relevant. Kasparov, et al. in EPO publication EP 1 112 765 A1, application 98963673.3, teach connecting a portable lottery device to a central computer (Claim 1). Paulsen in U.S. pre-grant document 2002/0193099 A1, application 09/882,588, teaches a personal gaming device. Itkis in U.S. patents 4,856,787 A and 5,478,084 A teaches bingo boards. The Derwent abstracts for Japanese publications JP 2003-110756 A, JP 07-325959 A, JP 07-334737 A, and JP 08-124019 A are

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considered to be relevant as they teach vending machines for renting portable electronic devices.

Conclusion

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

32. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew D. Hoel, Patent Examiner
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